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| 10/814,033 | 04/01/2004 | Yung-lung Tseng | | 6283 |
| | 7590 | 09/21/2005 | | |
| Yung-lung Tseng TCT Holdings, LLC 27236 Westridge Lane Languna Hills, CA 92653 | | | EXAMINER LEWIS, KIM M | |
| | | | ART UNIT 3743 | PAPER NUMBER |

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,033

Applicant(s)

TSENG ET AL.

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-23 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed Action.

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Drawings

2. The drawings are objected to because Fig. 2 should be enclosed in brackets since it appears on the same page with other figures.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "13", "14", "17", "18", "19" and "20".

4. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the phrase "permanently and sealing bonded" as recited in claims 1 and 19-23 is not present in the specification. Applicants are advised to add the phrase to the specification. Further, the recitation that "the first strip maintains its self-adhering capability when wet" is not in the specification. Applicants are advised to add this recitation to the specification. Applicants' still further fail to provide antecedent basis for "the second cushioning strip composed of material with non-slip surface" as recited in claim 10. Furthermore, "...a leather ***base material***, nature or artificial" (emphasis added by the examiner) is not in the specification. Additionally, the applicants should note that with respect to the second layer, the phrase "base material" lacks antecedent basis. Applicants are advised to also add these recitations to the specification.

6. The disclosure is objected to because of the following informalities: Page 8, line 8, "Insert" should read --insert--. Appropriate correction is required.

Claim Informalities

7. Claim 16 is objected to because of the following informalities: Claim 16, line 3, "fist" should read --first--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-8, 10,13-19 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 6,049,022 ("Tseng et al.").

As regards claim 1, Tseng et al. disclose gripping bandage adapted to be disposed over a finger to protect the finger when using a sports or hand tool implement, the bandage comprising: a first self-adhering strip having a first predetermined length; a second impact cushioning strip overlying a portion of, permanently and sealingly bonded to, the first self-adhering strip the second cushioning strip providing protection from abrasion and pressure when the bandage is applied to a finger (note abstract, claim 1 of Tseng et al. and col. 3, lines 24-43).

As regards claim 2, Tseng et al. disclose the gripping bandage of claim 1, wherein the first self-adhering strip is composed of elastic material (note claim 2 of Tseng et al. and col. 3, lines 27-30).

As regards claim 3, Tseng et al. disclose the gripping bandage of claim 1 wherein the second cushioning strip has a length shorter than the first predetermined length of the first strip (note claim 3 of Tseng et al. and col. 3, line 44).

As regards claims 4, Tseng et al. disclose the gripping bandage of claim 1 wherein the first strip and the second cushioning strip are of substantially equal width (note claim 4 of Tseng et al.).

As regards claim 5, Tseng et al. disclose the gripping bandage of claim 1 wherein the first self-adhering strip comprises a non-woven polymer fiber base material (note claim 5 of Tseng et al. and col. 3, lines 37-38).

As regards claim 6, Tseng et al. disclose the gripping bandage of claim 1, wherein the first strip maintains its self-adhering capability when wet (note claim 6 of Tseng et al.).

As regards claim 7, Tseng et al. disclose the gripping bandage of claim 1, wherein the first self-adhering strip is elastic in a longitudinal direction (note claim 9 of Tseng et al.).

As regards claim 8, Tseng et al. disclose gripping bandage of claim 1, wherein the first self-adhering strip is elastic in a latitudinal direction (note claim 12 of Tseng et al.).

As regards claim 10, Tseng et al. disclose the gripping bandage of claim 1 wherein the second cushioning strip composed of material with non-slip surface (note col. 3, lines 44-51).

As regards claim 13, Tseng et al. disclose the gripping bandage of claim 10 wherein the second cushioning strip comprises a fabric base material (note col. 3, lines 44-50, which discloses woven cotton (a fabric) base material).

As regards claim 14, Tseng et al. disclose a gripping bandage adapted to be disposed over a finger to protect the finger when using a sports or hand tool implement, the bandage comprising: a first self-adhering strip having a first pre-determined length; a second cushioning strip overlying a portion of, and bonded to, the first self-adhering strip; the second cushioning strip providing protection from abrasion and pressure when the bandage is applied to a finger; and the first self adhering strip comprising a non-woven polymer fiber base material with elastic threads extending through the fiber base material in a longitudinal direction (note claim 14 of Tseng et al. and col. 3, lines 24-43).

As regards claim 15, Tseng et al. disclose a gripping bandage adapted to be disposed over a finger to protect the finger when using a sports or hand tool implement, the bandage comprising; a first self-adhering strip having a first pre-determined length; a second cushioning strip overlying a portion of, and bonded to, the first self-adhering strip; the second cushioning strip providing protection from abrasion and pressure when the bandage is applied to a finger; and the first self-adhering strip comprising a non-woven polymer fiber base material and a layer of latex (note claim 13 of Tseng et al. and col. 3, lines 34-40).

As regards claim 16, Tseng et al. disclose a bandage adapted to be disposed over a finger to protect the finger when using a sports or hand tool implement, the bandage comprising; a first self-adhering strip having a first predetermined length; a

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second cushioning strip overlying a portion of, and bonded to the first self-adhering strip; the second cushioning strip providing protection from abrasion and pressure when the bandage is applied to a finger, an insert strip disposed between the first self-adhering strip and the second cushioning strip (note claim 15 of Tseng et al.).

As regards claim 17, Tseng et al. disclose the gripping bandage of claim 16 wherein the insert strip comprises at least one layer of foam material (note claim 16 of Tseng et al. and col. 4, lines 59-63).

As regards claim 18, Tseng et al. disclose the gripping bandage of claim 16 wherein the insert strip comprises at least one layer of cotton based material (note claim 17 of Tseng et al.).

As regards claim 19, Tseng et al. disclose a gripping bandage adapted to be disposed over a finger portion of a glove to protect the finger inside the glove when the glove is worn when using a sports or hand tool implement, the bandage comprising: a first self-adhering strip having a first predetermined length; a second impact cushioning strip overlying a portion of, permanently and sealingly bonded to, the first self-adhering strip; the second cushioning strip providing protection from abrasion and pressure when the bandage is disposed over a finger portion of the glove and the glove is worn when using a sports or hand tool implement (note claim 18 of Tseng et al).

As regards claim 21, Tseng et al. disclose a gripping bandage adapted to be disposed over a finger to protect the finger when using a sports or hand tool implement, the bandage comprising: a first self-adhering strip having a first predetermined length; a coat of adhesive material applied to a portion of surface of the first self-adhering strip', a

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second impact cushioning strip overlying a portion of, permanently and sealingly bonded to, the first self-adhering strip; the second cushioning strip providing protection from abrasion and pressure when the bandage is applied to a finger (note claim 10 of Tseng et al.).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claim 1, 9, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0052570 A ("Naimer").

As regards claim Naimer substantially discloses applicant's present claimed invention. More specifically, Naimer discloses a bandage **capable** of being disposed over a finger to protect the finger when using a sports or hand tool implement, the bandage comprising: a first self-adhering strip (12) inherently having a first predetermined length since its length is not infinite; a second impact cushioning strip (pad 14) overlying a portion of the first self-adhering strip, the second cushioning strip **capable** of providing protection from abrasion and pressure when the bandage is applied to a finger.

Naimer discloses various adhesive in para. [0058] that may be used to affix the pad to the first self-adhering strip. Naimer fails to teach that the pad is permanently and sealing bonded to the first self-adhering strip. The examiner contends that it would have been *prima facie* obvious to one having ordinary skill in the art to use an adhesive that permanently and sealing affixes the pad to the first self-adhering strip in order to prevent detachment of the pad from the first self-adhering strip.

As to the recitation of a gripping bandage, Naimer discloses the use of COBAN[®] as a material of construction for the first self-adhering strip. COBAN[®] comprises latex which is capable of aiding in gripping of an object. Thus, the bandage of Naimer is considered a gripping bandage.

As regards claim 9, 10 and 12, Naimer discloses the material of construction for the pad in para. [0059]. As can be read from this paragraph, one of the materials includes foam.

Naimer is silent in para.[0059] to self-adhering padding material or non-slip padding material. Thus, it may be inferred that the padding material of Naimer do not include a base material that is non-slip or self-adherent.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng et al.

As regards claim 20, Tseng et al. substantially disclose the gripping bandage as presently claimed. More specifically Tseng et al. disclose a gripping bandage adapted to be disposed over a finger to protect the finger when using a sports or hand tool implement, the bandage comprising: a first self-adhering strip having a first predetermined length; a second elastic impact cushioning strip overlying a portion of, permanently and sealingly bonded to, the first self-adhering strip; the second cushioning strip providing protection from abrasion and pressure when the bandage is applied to a finger.

Tseng et al. fail to teach a double sided glue tape strip applied to a portion of. surface of the first self-adhering strip, rather discloses an adhesive material applied to a portion of the first surface of the first self-adhering strip, which performs the same function as the double-sided glue tape strap of the instant invention since it inherently has two adherent surfaces.

In light of Tseng et al.'s disclosure of an adhesive material applied to a portion of the first surface of the first self-adhering strip, which inherently has two adherent surfaces, the examiner contends that it would have been an obvious design choice to one having ordinary skill in the art to substitute the adhesive material of Tseng et al. for a double sided glue tape strip since they perform the same function.

15. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tseng et al. in view of U.S. Patent No. 5,939,339 ("Delmore et al.").

As regards claims 22 and 23, Tseng et al. substantially discloses all of the claimed features as evidenced by claim 19 of Tseng et al. Tseng et al., however, fail to teach that the cushioning strips is bonded to the first self-adhering strip by sewing or gluing and sewing.

Delmore et al. teach it is conventional in the art to attach a pad to a self-adhering strip by "...stitching, needle-tacking, ultrasonic welding or bonding with a suitable adhesive" (col. 3, lines 6-9). Thus, disclosing the equivalents of stitching and adhesive bonding (gluing).

It would have been obvious to one having ordinary skill in the art at the time of invention to attach the pad of Tseng et al. to the first self-adhering strip by stitching since Delmore et al. teach the equivalents of stitching and gluing a pad to a self-adhering strip.

It would also have been *prima facie* obvious to one having ordinary skill in the art to use both gluing and stitching in order to better secure the pad to the self-adhering strip in the event that one of other attachment means fails.

Allowable Subject Matter

16. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

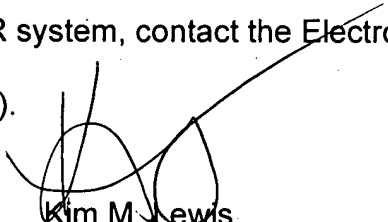
17. The balance of the prior art made of record of form PTO-892 and not relied upon is considered pertinent to applicant's disclosure in that they disclose at least one of the claimed features of applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett, can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kim M. Lewis
Primary Examiner
Art Unit 3743

Kml
September 14, 2005